

REMARKS

35 USC § 103:

Claims 1-3, 5 and 7-9

Claims 1-3, 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (U.S. Pat. No. 6,329,735 [hereinafter “Tanaka”]) in view of Schmider (U.S. Pat. No. 4,501,983). Applicant respectfully traverses the rejection in view of the following remarks.

The invention provides a rotating machine comprising, *inter alia*, a positioning unit which positions a lead wire in a joint portion. Prior devices have suffered from a lack of efficient positioning, as noted on page 2 of the present specification.

The Examiner cites Tanaka for allegedly disclosing a majority of the features recited in claim 1, but acknowledges that this reference fails to disclose a positioning unit which positions the lead wire to be welded in the joint portion. Thus, the Examiner cites Schmider and applies elements 91-93 shown in Figs. 5 and 6. Elements 91-93 are disclosed as being used to protect the cables from tension applied from outside the motor. (See col. 5, lines 63-68 of Tanaka.)

Applicant further defines the positioning unit of claim 1 as having a tapered face. In an exemplary embodiment, the present specification describes the tapered face as providing benefits such as those disclosed in lines 6-12 of page 13.

In the last paragraph of page 4 in the Office Action, the Examiner acknowledges that Schmider fails to disclose a positioning unit having a tapered face. Thus, he alleges that it would have been an obvious matter of “design choice” to provide the elements 91-93 with a tapered face. Applicant submits that the claimed positioning unit with a tapered face, in combination

with the other claimed features, is not taught nor suggested by the applied art and provides benefits over the art as noted in the present specification. Applicant further submits that this feature is not merely a matter of “design choice.”

In particular, to establish a *prima facie* case of obviousness, there must be established, *inter alia*, that there was some suggestion or motivation to modify the reference so as to obtain the recited features. The Examiner has the initial burden of establishing this *prima facie* case of obviousness. This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. See *In re Lulu*, 747 F.2d 703 (Fed. Cir. 1984). The Examiner has apparently not found any art which either discloses the claimed features or provides motivation to derive the features.

The Examiner’s position, however, ignores the fundamental requirements of establishing a *prima facie* case of obviousness. For example, as noted in the MPEP §2143.01, “THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION.” In this case, the prior art does not suggest the desirability of the claimed invention. No where do the references note the deficient aspects pointed out by the Applicant (e.g., lack of proper guidance of a lead wire to a welding position), nor would the references have motivated one to arrive at the unique solution that is described in the claims. Thus, Applicant submits that there is no actual basis to support a legal conclusion of obviousness.

Further, Schmider does not provide any motivation to modify the structures 91-93 because, for example, these elements are not used for “leading” the cables to a welding position, as the wire is led in the invention. Instead, the elements 91-93 are used merely to clamp the

connecting cables. As one skilled in the art would realize, the connection cables of Schmider would be pushed into the elements 91-93 after the cables have been led into an interior of the motor, so that the elements 91-93 could perform their function of preventing tugging forces from pulling the cables out of the motor.

Accordingly, Applicant submits that claim 1 is not taught nor suggested by Tanaka in view of Schmider and requests that the rejection thereof under 35 U.S.C. § 103(a) be withdrawn. The rejection of dependent claims 2, 5 and 7-9 should likewise be withdrawn at least by virtue of these claims respectively depending upon claim 1.

Claim 4

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in view of Schmider and further in view of Nishmura (U.S. Pat. No. 5,280,207). Applicant respectfully traverses this rejection in view of the following remarks.

The Examiner acknowledges that Tanaka and Schmider fail to disclose that the lead wire has a conductor including a plurality of element wires. Thus, the Examiner cites Nishmura for disclosing a plurality of wires, as shown in Fig. 4. Applicant submits that the disclosed wires in Nishmura would not have made up for the deficient teachings of Tanaka and Schmider in regard to claim 1. Thus, the features of claim 4 would not have been taught nor suggested by the combination of Tanaka, Schmider and Nishmura at least due to claim 4 depending on claim 1.

Claim 6

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in view of Schmider and further in view of Iwata et al. (U.S. Pat. No. 5,942,822 [hereinafter "Iwata"]). Applicant respectfully traverses this rejection in view of the following remarks.

The Examiner acknowledges that Tanaka and Schmider fail to disclose a grommet that has a thinned portion, as recited in claim 6, and cites Iwata for alleging disclosing this feature. Applicant submits that Iwata would not have made up for the deficient teachings of Tanaka and Schmider in regard to claim 1. Thus, the features of claim 6 would not have been taught or suggested by the combination of Tanaka, Schmider and Iwata at least due to claim 6 depending on claim 1.

NEW CLAIM:

Applicant adds new claim 10 to obtain more varied protection for the invention and submits that claim 10 is patentable over the references at least by virtue of it depending from claim 1, in addition to its individual recitations.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No.: 10/791,526

Attorney Docket No.: Q80128

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

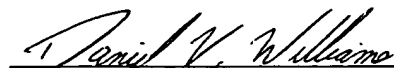
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Daniel V. Williams
Registration No. 45,221

Date: October 18, 2004